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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,794	06/01/2000	Glenn Rolus Borgward	65705-0002	1859

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EXAMINER

MENGISTU, AMARE

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/508,794

**Applicant(s)**

BORGWARD, GLENN ROLUS

**Examiner**

Amare Mengistu

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 140-151, 153-156, 158-164, 167-173, 175-178, 180-192 and 195-211 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 140-151, 153-156, 158-164, 167-173, 175-178, 180-192 and 195-211 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. Claims 198-211 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 198,203 recites “virtual operating elements may be removed”; “virtual operating elements may be actuated with a thumb” is confusing. It is not clear that the virtual operating elements can be removed or can be actuated with a thumb.

The Applicant is not even sure whether these virtual operating elements can be removed or not, or can be actuated with a thumb or not.

### ***Claim Rejections - 35 U.S.C. § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 f this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

3. Claims 140, 151, 162-165, 167, 168, 173, 184-186, 193, 195-197, 208-211 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Huffman et al** (5,893,132) in view of **Eberhard et al** (6,331,867).

As to claims 140, 151, 162-165, 167, 168, 173, 184-186, 193, 195-197, 211 **Huffman et al** (hereinafter **Huffman**) discloses an electronic book comprising: a casing having at least one display unit comprising a touch screen operable by a finger or pen to use as operating processing tool (see, figs. 2, 3 (130) and figs. 5-22, col. 8, lines 36-42); the casing having at least a first part and a second part (fig. 2 (130, 132)), said first and second parts being hinged together by a hinge means such that casing is adapted to be folded open and shut (see, figs. 1 and 2 (110)); the touch screen being adapted to provide at least one virtual operating element (fig. 11 (254-258); fig. 15 (294); fig. 21 (360)); an operating functions comprises at least one of leafing-through functions or scrolling functions (see, fig. 29 (516, 522, 526), fig. 28 (480, 482, 484, 486)); at least one manipulation region for use by a user (fig. 11 (267-269), fig. 21 (360)), said manipulation region being designed in the side zone of the casing (fig. 11 (267, 268, 269) and fig. 21 (360)), at least one operating element triggering leafing through functions (col. 8, lines 51- col. 9, lines 6). Moreover, **Huffman** teaches a control unit (fig. 3 (152)), a storage medium (fig. 3 (136, 154) same as RAM, ROM), information may be present in the form of text (figs. (19-20)).

As to claims 208-210, **Huffman et al** discloses a mobile display means for displaying information comprising: a housing including at least one display area for displaying the information (see, fig. 2 (130 or 132), fig. 5 (130), col. 5, lines 49-62), and further including at least one navigation input means for navigating through the information, (fig. 11 (271-273), fig. 21 (360, 362)), the navigation input means being

distinct from the at least one display area, the housing having at least two housing parts hinged together by a hinge means (fig.1 (102,104) spine (110), col.4, lines 32-44), at least one navigation input means (fig. 11 (271,-273), fig.21 (360,362)) being located on a side of the housing opposite the display area (fig.2 (132)).

**Huffman** did not explicitly teach that user can execute operations /multifunction operation with the fingers of a hand holding the case and where a operation function can be triggered by the one operation element by action of the thumb (index, middle or ring fingers) of the hand without shifting of the wrist. However; **Eberhard et al** (hereinafter **Eberhard**) clearly teaches that it is conventional to trigger one of the multifunction operation elements/keyboard with a fingers/thumbs the hand holding the casing without shifting the wrist (fig.2 (82,86)).

Therefore it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to incorporate the method of manipulating the multifunction operation of the element using a fingers as taught by **Eberhard** into the system of **Huffman** because this will provide simplicity to **Huffman's device** by holding the casing by hand and manipulating the operation element at the same time.

4. Claims 142-145, 158-161,180-183,187-191, are rejected under 35 U.S.C. 103(a) as being unpatentable over **Huffman** in view of **Eberhard** as applied to claim140 and 168 above, and further in view of **Lebby et al** (5,534,888).

As to claims 142-145, 158-161,180-183,187-191, **Huffman** as modified by **Eberhard** teaches a digital display device having a hinge and also an interface unit for inputting information (fig.1 (110) and fig.3 (150)), but has failed to teach hinge includes

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an electronic compartment and interface unit for supplying energy. The patent of **Lebby et al** (hereinafter **Lebby**) clearly teaches that it is well known for a digital display device hinge to have an electronic compartment with a connector/adaptor to be coupled to an external device (col.2, lines 59 – col.3, lines 9) also teaches an interface unit for supplying energy (fig.5 (562)).

Therefore it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to substitute the **Huffman's** hinge with the hinge system of **Lebby**, so that this will allow **Huffman's** digital display to provide several other alternatives for inputting information into the display.

5. Claims 141 and 146 rejected under 35 U.S.C. 103(a) as being unpatentable over **Huffman** in view of **Eberhard** as applied to claim 140 and 168 above, and further in view of **Shibasaki et al** (5,270,946).

As to claims 141 and 146, **Huffman** as modified by **Eberhard** discloses a digital book includes a hinge but has failed to teach having LED to indicate the battery power. **Shibasaki et al** is cited to teach that it is conventional for digital book to have an LED to show the states of the battery (see, Abstract, col.3, lines 28-44).

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to have incorporate an LED by the hinge to indicate the battery power as taught by **Shibasaki et al** into the Digital book of **Huffman**, because this is an advantage for the user to indicate if it is time to charge the battery.

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6. Claims 146 and 192 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Huffman** in view of **Eberhard** as applied to claims 140 and 168 above, and further in view of **Dao et al** (5,049,862).

As to claims 146 and 192, **Huffman** as modified by **Eberhard** teaches a digital book having a first and a second display (fig.2 (130,132)) but silent as one of the display is removable. **Dao et al** shows that is well known to detach one of the display the digital displays (see, Abstract, also figs. 5 and 6).

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to have been use **Dao's** method of remove one of the displays into the system of **Huffman**, since this will provide convenience to the user by detaching on of the display when there is a need to use only one display.

7. Claims 198-200,205 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Huffman**.

As to claims 198-200,205 **Huffman** discloses a display device having a casing (fig.1 (100)); at least one display unit (fig.11 (130)) comprising a central display area (the center of (130)) and a marginal display area including a plurality of virtual operating elements (fig.11 (254,256,258)) each triggering at least one operating function when actuated by touch (in fig.11, see the hand to actuate the operating functions (254,256, 258), said at least on display unit disposed within said casing, an operating functions comprises at least one of leafing-through functions or scrolling functions (see, fig.29 (516,522,526),fig.28 (480,482,484,486)).

**Huffman** did not expressly state that the plurality of virtual operating elements might be removed from view as said display apparatus displays information. However, one skill in the art would have recognize that the **Huffman's** device can remove the virtual operating elements when an information is display or turn the page.

As to claims 199,200 **Huffman** teaches that the said casing includes a first portion rotatably connected to a second portion/ open or closed position (fig 2, first and second portion (102,104) connected (fig.1)).

As to claim 205, **Huffman** teaches that said operation function includes one of more functions such as leafing through functions (fig.29 (516,522,526)); scrolling functions (fig.28 (480)).

In regard to claims 206, 207 **Huffman** also teaches a first portion is a display device and a second portion includes an interface for inputting information/keyboard (see, figs 5-15 (a display area) and 130 (information inputting area), fig 21 (130), keyboard (360)).

8. Claims 201-204 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Huffman** in view of **Lebby et al** (5,534,888).

As to claims 201-204, **Huffman** discloses at least one manipulation region but has failed to teach the manipulation region disposed in a casing. The patent of **Lebby** is cited to teach that is conventional for electronic book to have a manipulation region to be located in the casing (fig.1 (117)) and faces opposite of to plurality of virtual operating elements (fig.2 (417)).

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to incorporate the Lebby's method of locating the manipulation region in the casing into the casing of **Huffman**, because this will allow the user to easily activate the manipulation region by holding the casing with the same hand.

The manipulation region of **Lebby** (fig.1 (117)) may be actuated by at least one finger of the hand without movement said hand gripping a casing and said plurality of virtual operating elements of **Huffman** (fig.11 (254,256,258)) are actuated by finger may be can also be actuated by thumb or nay other fingers.

### ***Response to Arguments***

9. Applicant's arguments filed on 6/07/2004 have been fully considered but they are not persuasive.

Applicant argues that the examiner ignores the claim limitation requiring *fingers manipulate the manipulation regions while the virtual operating elements are actuated by the thumb without shifting of the wrist of the hand holding the casing*. However the Examiner strongly disagrees with Applicant's assertion. The patent of **Huffman** clearly teaches *the manipulation regions be manipulated by fingers (see, fig.11)* and **Eberhard** suggests *the virtual operating elements are actuated by the thumb without shifting of the wrist of the hand holding the casing (see, fig.2 (82))*. That means holding the casing with one hand while actuating the virtual operating elements with a thumb and manipulating

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the manipulation region with the other hand (finger). Thus, the combination of these two references teaching will reads on Applicant's claimed invention.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amare Mengistu whose telephone number is (703) 305-4880. The examiner can normally be reached on M-F, T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bain Shalwala can be reached on (703) 305-4938. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

  
Amare Mengistu  
Primary Examiner  
Art Unit 2673

A.M  
August 21, 2004